

REMARKS

The last Office Action of March 1, 2004 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-22 are pending in the application. Claims 2, 3 and 18 have been amended. Claims 1, 21 and 22 have been canceled. Claims 23-25 have been added. Claims 4-17 are withdrawn from consideration as part of an election requirement. A total of 22 claims is now on file. No claim surcharge is due. No amendment to the specification has been made.

It is further noted that claims 1 and 2 are rejected 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,486,185 (hereinafter: "Freitas").

Claims 2, 3 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Freitas in view of U.S. Pat. No. 6,066,102 (hereinafter: "Townsend").

Claim 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Freitas in view of U.S. Pat. No. 5,047,008 (hereinafter: "de Juan").

As noted by the Examiner, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species, provided

that all claims to all additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141.

REJECTION OF CLAIMS 1 AND 2 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Applicant has cancelled claim 1, so that the rejection is moot. Furthermore, applicant has amended claim 2 to address the §112 rejection. Optical guide has been properly changed to light guide for which there was antecedent basis. These changes are cosmetic in nature to remove a typographical error and should not be considered as a narrowing amendment to trigger prosecution history estoppel.

Withdrawal of the rejection of the claims 1 and 2 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

**REJECTION OF CLAIMS 1 AND 20 UNDER 35 U.S.C. §102(b) AS BEING
ANTICIPATED BY FREITAS.**

In order to clearly distinguish the present invention from Freitas, applicant has cancelled claim 1 and presents new claim 23. Claim 23 is directed to the microsurgical device as seen in Figure 2 of the application. In the claim, the relationship of the housing body and the cutting device is set forth. The functional unit which is connected to the cutting device is in operative relationship with the housing body, such that when semicircular the housing parts are squeezed together, the function of the cutting device is initiated.

Claim 23 distinguishes over the Freitas dereference since the device in Freitas does not incorporate the structural parts as presently claimed. Specifically, the body the housing consists of two semicircular parts that are spread apart by means of a spring action. Freitas does not incorporate these structural elements and thus the rejection that the Freitas reference anticipates the claimed device has been overcome.

With respect to claim 20, this claim depends on new claim 23 and thus contains all the limitations of claim 23 and therefore is allowable in the same manner as claim 23.

Withdrawal of the rejection of claims 1 and 20 under 35 U.S.C. §102(b) is thus respectfully requested.

**REJECTION OF CLAIMS 2, 3 AND 18 UNDER 35 U.S.C. §103(a) AS BEING
UNPATENTABLE OVER FREITAS IN VIEW OF TOWNSEND**

In view of the Examiner's grounds for rejection, applicant has canceled original claim 1 in favor of independent claim 23. New claim 23 sets forth limitations that distinguish over the Freitas reference as discussed supra. Since claims 2, 3 and 18 are dependent on claim 23, they are therefore also patentably distinguished over the cited prior art.

For the reasons set forth above, it is applicant's contention that neither Freitas nor Townsend, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 20.

Withdrawal of the rejection of claims 2, 3 and 18 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

**REJECTION OF CLAIM 19 UNDER 35 U.S.C. §103(a) AS BEING
UNPATENTABLE OVER FREITAS IN VIEW OF DE JUAN**

The Examiner's rejection is respectfully traversed.

The Freitas laparoscopic device is not usable for carrying out surgery on retinal tissue or for use in vitrectomy. The probe is relatively much larger than the rod moving therein, so that tissue would slide into the probe upon entering the vitreous. The Examiner's postulation that de Juan reference can be combined with Freitas must also fail since the motion of the Freitas cutting instrument is

carried out by the probe being moved forward while the clamp is being closed. In de Juan, the vitreous is being drawn into the outer tube. This action is specifically avoided in Freitas and a seal inside the probe is designed to avoid such. The cutting action in de Juan is unlike the cutting action in the presently claimed invention, in that the tissue needs to enter the probe. In contrast, entering of tissue into the probe is to be avoided and the rod sits in positive engagement with the probe.

Accordingly, a combination of the teachings of Freitas and de Juan does not lead to result desired by the claimed device.

Withdrawal of the rejection of claim 19 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

CITED REFERENCES

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claims. It is thus felt that no specific discussion thereof is necessary.

CONCLUSION

Applicant believes that when the Examiner reconsiders the claims in the light of the above comments, he will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a microsurgical instrument having a operational body structure and a cutting device of the type as claimed.

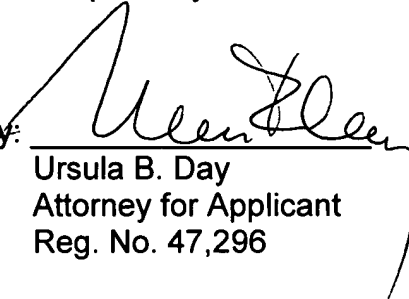
In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to Deposit Account No. 06-0502.

Respectfully submitted,

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